## KRAFT FOODS SCHWEIZ HOLDING GmbH v. PENDAFTAR CAP DAGANGAN

HIGH COURT MALAYA, KUALA LUMPUR
WONG KIAN KHEONG JC
[ORIGINATING SUMMONS NO: 24IP-44-11-2015]
15 AUGUST 2016

***LIMITATION:*** *Expiry of period – Extension – Application to register trade mark refused by Registrar of Trade Marks ('Registrar') – Application to Registrar for extension of time to appeal to High Court pending Registrar's refusal – Registrar gave two-month extension of time – Originating summons filed out of time – Rules of Court 2012, O. 87 r. 3*

The plaintiff applied to the defendant ('the Registrar') to register a 3D prism-shaped in reddish brown colour described as 'Toblerone Chocolate Teeth 3D in colour' for goods in class 30 (chocolate, chocolate confectionary, cocoa, pastry and ice-cream) ('the proposed trade mark'). The Registrar refused to register the proposed trade mark on the ground that, *inter alia*, the proposed trade mark did not fall within the definitions of 'mark' and 'trade mark' in s. 3(1) of the Trade Marks Act 1976 ('the TMA') ('the Registrar's refusal'). The plaintiff's agent applied to the Registrar for an extension of time to appeal to the High Court pending the Registrar's refusal. In a letter dated 22 September 2015, the Registrar gave the plaintiff a two-month extension of time until 27 October 2015 for the plaintiff to file the originating summons ('the OS'). The plaintiff filed the present OS on 3 November 2015, which was seven days after the extension. The plaintiff sought, among others, (i) the reversal and setting aside of the Registrar's refusal; and (ii) an order that the Registrar accept and register the proposed trade mark. The primary issue that arose for the court's adjudication, *inter alia*, was whether the OS was time-barred under O. 87 r. 3 of the Rules of Court 2012 ('the ROC').

**Held (dismissing originating summons):**

**(1)** According to O. 87 r. 3 of the ROC, the plaintiff's appeal against the Registrar's refusal by way of this OS 'shall' be brought within one calendar month from 27 July 2015. As such, this OS should be filed on or before 27 August 2015. (para 18)

**(2)** Although parties may consent to an extension of time in writing under O. 3 r. 5(3) of the ROC, such a provision does not apply to this OS because O. 3 r. 5(3) only allows parties to consent in writing to an extension of time to serve, file or amend any pleading or other document beyond a time period, as stipulated in the ROC. Order 3 r. 5(3) of the ROC could not authorise an extension of time to file an action, especially when there is a specific time period to file this OS, as provided in O. 87 r. 3 of the ROC. If this OS is time-barred under O. 87 rr. 3 and 8, despite the Registrar's extension, the court has no

jurisdiction or competence to hear this OS and the parties' consent, election, waiver or acquiescence could not confer jurisdiction or competence for the court to hear the OS. (para 21)

**Case(s) referred to:**

*Airasia Bhd v. Rafizah Shima Mohamed Aris [2015] 2 CLJ 510 CA* ***(refd)***

*Asia Commercial Finance (M) Bhd v. Pasadena Properties Development & Ors [1990] 2 CLJ 961; [1990] 1 CLJ (Rep) 606 HC* ***(refd)***

*Bato Bagi & Ors v. Kerajaan Negeri Sarawak & Another Appeal [2011] 8 CLJ 766 FC* ***(refd)***

*Blue Paraffin Trade Mark [1977] RPC 473* ***(refd)***

*Boustead Naval Shipyard Sdn Bhd v. Dynaforce Corporation Sdn Bhd [2014] 5 CLJ 533 CA* ***(refd)***

*Godrej Sara Lee Ltd v. Siah Teong Teck & Anor (No 2) [2008] 7 CLJ 24 HC* ***(refd)***

*Hadmor Productions Ltd v. Hamilton [1983] AC 191* ***(refd)***

*Hj Abdul Ghani Ishak & Anor v. PP [1981] 1 LNS 96 FC* ***(refd)***

*Hoecheong Products Co Ltd v. Cargill Hong Kong Ltd [1995] 1 WLR 404* ***(refd)***

*Illinois Tool Works, Inc v. Pendaftar Cap Dagangan, Malaysia [2010] 3 CLJ 837 HC* ***(refd)***

*Lim Yew Sing v. Hummel International Sports & Leisure A/S [1996] 4 CLJ 784 CA* ***(refd)***

*Malayan United Finance Bhd, Johore Bahru v. Liew Yet Lan [1989] 1 LNS 115 HC* ***(refd)***

*PP v. Narongne Sookpavit & Ors [1985] 1 LNS 20 HC* ***(refd)***

*PP v. Yap Min Woie [1995] 4 CLJ 692 FC* ***(refd)***

*Re Coca Cola Applications [1986] 2 All ER 274* ***(not foll)***

*Registrar of Trade Marks v. W & G Du Cros Ltd [1913] AC 624*

*Smith Kline & French Laboratories Ltd v. Sterling-Winthrop Group Ltd [1975] 2 All ER 578* ***(foll)***

*Yong Teng Hing B/S Hong Kong Trading Co & Anor v. Walton International Ltd [2012] 6 CLJ 337 FC* ***(refd)***

*Yorkshire Copper Works Ltd v. Registrar of Trade Marks [1954] 1 All ER 570* ***(refd)***

**Legislation referred to:**

Federal Constitution, art. 160(2)

Industrial Designs Act 1996, s. 3(1)

Interpretation Acts 1948 and 1967, s. 3

Rules of Court 2012, O. 3 r. 5, O. 32 r. 1, O. 87 rr. 1, 3, 8

Trade Marks Act 1976, ss. 3(1), 10(1)(a), (b), (c), (d), (e), (2A), (2B)(a), 14(2), 18, 19, 25(1), (3), (5), (6), 35(1)

Trade Marks Regulations 1997, regs. 5, 29(3), Third Schedule

Trade Marks Act 1995 [Aus], ss. 6, 17

Trade Marks Act (Cap 332) [Sing], s. 2(1)

Trade Marks Act 1938 (since repealed) [UK], ss. 9(3)(a), (b), 68(1)

Trade Marks Act 1994 [UK], s. 1(1)

**Other source(s) referred to:**

Teo Bong Kwang, Trade Mark Law and Practice, (2001), p 88

*For the plaintiff - Azura Adnan; M/s Miranda & Samuel*

*For the defendant - Illya Hashim, Hani Afiqah Mohd Jamal & Azrul Shahreen Abdul Aziz; Perbadanan Harta Intelek Malaysia*

*Reported by Najib Tamby*

## JUDGMENT

### Issues

**[1]** This case discusses the following issues:

(i) whether this originating summons (this OS) is time-barred under O. 87 r. 3 of the Rules of Court 2012 (RC);

(ii) whether art. 15(1) of the Agreement on Trade Related Aspects of Intellectual Property Rights 1994 (TRIPS Agreement) applies to the definitions of "mark" and "trade mark" in s. 3(1) of the Trade Marks Act 1976 (TMA);

(iii) whether the court can refer to the Registrar's *"Manual of Trade Marks Law & Practice"*, 2nd edn (2003) (Registrar's Manual) in construing the meaning of "mark" and "trade mark" in s. 3(1) of the TMA;

(iv) whether a three-dimensional (3D) prism mark or a "shape" mark is a "mark" and "trade mark" in s. 3(1) of the TMA; and

(v) whether a 3D prism mark of the plaintiff company (plaintiff) is distinctive of the plaintiff's goods within the meaning of s. 10(1)(e), (2A) and (2B) of the TMA so as to be registrable under the TMA.

### Facts

**[2]** The plaintiff is incorporated in Switzerland and manufactures confectionary, food and beverages. The plaintiff's products have been exported throughout the world.

**[3]** This case concerns the "Toblerone" brand of chocolates and confectionary produced by the plaintiff. The "Toblerone" mark is in the shape of a prism which signifies the Swiss Alps mountain range and the Swiss origin of "Toblerone" products.

**[4]** The plaintiff has registered the "Toblerone" mark in various two-dimensional (2D) forms throughout the world. In Malaysia, the plaintiff has registered 22 "Toblerone" marks in various 2D forms for goods in Classes 25, 29 and 30 (plaintiff's registered 2D trade marks).

**[5]** On 7 June 2012, the plaintiff applied to the Registrar of Trade Marks (Registrar) to register a 3D prism-shaped mark in reddish brown colour described as "Toblerone Chocolate Teeth 3D In Colour" for goods in class 30 (chocolate, chocolate confectionary, cocoa, pastry and ice-cream) (Proposed Trade Mark). A 2D depiction of the proposed trade mark is annexed to this judgment.

**[6]** The Registrar gave notice by way of a letter dated 14 December 2012 to the plaintiff's trade mark agent (plaintiff's agent) which stated, among others:

(i) the proposed trade mark did not comply with s. 10(1)(d) of the TMA because the proposed trade mark was a word which had no direct reference to the character or quality of the plaintiff's goods; and

(ii) the proposed trade mark was not distinctive as required by s. 10(1)(e) of the TMA because the proposed trade mark was not capable of distinguishing the plaintiff's goods in the course of trade.

**[7]** The plaintiff's agent presented written submission to the Registrar in support of the registration of the proposed trade mark. The plaintiff's agent also appeared in a hearing before the Registrar on 9 June 2014.

**[8]** By way of a letter dated 17 October 2014, the Registrar informed the plaintiff's agent that the Registrar had refused to register the proposed trade mark (Registrar's refusal).

**[9]** Upon request by the plaintiff's agent, the Registrar gave written grounds for the Registrar's refusal (Registrar's grounds) by way of a letter dated 27 July 2015 (Registrar's letter dated 27 July 2015).

**[10]** The Registrar's grounds stated, among others, that the proposed trade mark did not fall within the definitions of "mark" and "trade mark" in s. 3(1) of the TMA.

**[11]** By way of a letter dated 14 August 2015, the plaintiff's agent applied to the Registrar for an extension of time to appeal to the High Court against the Registrar's refusal. In the Registrar's letter dated 22 September 2015 (Registrar's letter dated 22 September 2015) the Registrar gave a two month extension of time from 27 August 2015 to 27 October 2015 for the plaintiff to appeal to the High Court against the Registrar's refusal.

**This OS**

**[12]** This OS was filed on 3 November 2015 and prayed for, among others:

(i) the Registrar's refusal be reversed by the High Court and set aside; and

(ii) the Registrar be ordered to accept and register the proposed trade mark.

**[13]** The plaintiff's learned counsel contended as follows, in support of this OS:

(i) the definition of a "mark" in s. 3(1) of the TMA is a wide and inclusionary one. The definition of a "mark" in s. 3(1) of the TMA is in *pari materia* with the definition of a "mark" in s. 68(1) of the Trade Marks Act 1938 of the United Kingdom (TMA 1938 (UK)). The plaintiff contends that the proposed trade mark falls within the meaning of "device" in the definition of a "mark" in s. 3(1) of the TMA. The plaintiff relied on the following English cases:

(a) The House of Lords case of *Smith Kline & French Laboratories Ltd v. Sterling-Winthrop Group Ltd* [1975] 2 All ER 578; and

(b) The Court of Appeal's decision in *Blue Paraffin Trade Mark* [1977] RPC 473;

(ii) the plaintiff cited para. 12.221 of the Registrar's manual and alleged that on "so many occasions" previously, the Registrar had registered shape marks. A list of shape marks registered by the Registrar had been given in Schedule A to the plaintiff's written submission;

(iii) The plaintiff referred to the opinion of Dr Ida Madieha bt Abdul Ghani Azmi (Dr Ida) in "Trade Marks Law in Malaysia" (2003), at p. 18, which stated:

> In practice, representation of a 3D mark has been accepted by the Malaysian Trade Mark Registrar. See s 6.26, Manual of Trade Mark Law & Practice in Malaysia (WIPO, Geneva 1989);

(iv) the proposed trade mark is a figurative mark and is not made up of any word. As such, s. 10(1)(d) of the TMA does not apply to the proposed trade mark. Reliance has been placed on Ramly Ali J's (as he then was) judgment in the High Court case of *Illinois Tool Works Inc v. Pendaftar Cap Dagangan, Malaysia* [2010] 3 CLJ 837;

(v) the proposed trade mark is distinctive as understood in s. 10(1)(e), (2A) and (2B) of the TMA;

(vi) the Registrar had exercised his discretion unlawfully in respect of the Registrar's refusal. The plaintiff relied on the following cases:

(a) The English House of Lords decision in *Registrar of Trade Marks v. W & G Du Cros Ltd* [1913] AC 624; and

(b) *Illinois Tool Works Inc*;

(vii) the proposed trade mark is merely an extension of the plaintiff's two earlier registered Trade Mark Nos. 96005523 (a combination of the word "TOBLERONE" and a 3D shape) and M/081509 (a figurative prism shape mark with the word "TOBLERONE") (plaintiff's two registered trade marks). In the plaintiff's two registered trade marks, there was no disclaimer to the plaintiff's exclusive use of the plaintiff's two registered trade marks. Consequently, the plaintiff was entitled to the exclusive use of the 3D prism shape of the proposed trade mark;

(viii) the trade marks legislation in the United Kingdom (UK), Australia and Singapore, have recognised the registration of 3D marks;

(ix) the Registrar's grounds had relied on the English House of Lords case of *Re Coca Cola Applications* [1986] 2 All ER 274 (*Coca Cola*'s case). *Coca Cola*'s case does not apply as the Coca Cola bottle has now been registered as a trade mark; and

A (x) Malaysia is a signatory of the TRIPS agreement. Article 15(1) of the TRIPS agreement has provided a wide definition of a trade mark as any "sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark".

B **[14]** The Registrar advanced the following submission, among others, to oppose this OS:

(i) the proposed trade mark is not a "mark" under s. 3(1) of the TMA. The definition of a "mark" in s. 3(1) of the TMA does not include a "shape". The shape of a product is "more suitable" to be protected C under the Industrial Designs Act 1996 (IDA). Section 3(1) of the IDA provides that an "industrial design" means, among others, "features of shape";

(ii) the proposed trade mark does not fall within the definition of a "trade D mark" s. 3(1) of the TMA. Accordingly, the proposed trade mark cannot be protected under the TMA;

(iii) the definition of a "trade mark" in s. 1(1) of UK's Trade Marks Act 1994 (TMA 1994 (UK)) has expressly provided that a "trade mark" may consist of, among others, "the shape of goods or their packaging". E Such a definition is not found in s. 68(1) of the TMA 1938 (UK). Our TMA is based on TMA 1938 (UK) and not TMA 1994 (UK). The defendant relied on *Coca-Cola*'s case which had interpreted TMA 1938 (UK) and had held that the function of TMA 1938 (UK) was to protect a distinctive mark but not the article marked, such as a container or F a bottle;

(iv) the TMA does not provide for a "figurative" mark. The Registrar uses the term "figurative" mark in the Registrar's computer system for the purpose of trade marks searches. Such a use is in accordance with the "international classification of the figurative elements of marks G established pursuant to the Vienna agreement of 12 June 1973" as provided in reg. 5 and the Third Schedule to the Trade Marks Regulations 1997 (TMR);

(v) the proposed trade mark had not been used in relation to the plaintiff's goods. The plaintiff did not use the proposed trade mark on the H package of the plaintiff's goods. The defendant cited Ramly Ali J's (as he then was) judgment in the High Court case of *Godrej Sara Lee Ltd v. Siah Teong Teck & Anor (No 2)* [2008] 7 CLJ 24; [2007] 7 MLJ 164;

(vi) the lack of a disclaimer in respect of the plaintiff's two registered trade marks, does not entitle the plaintiff to register the proposed trade mark; I

(vii) the proposed trade mark is not distinctive of the plaintiff's goods;

(viii) since trade marks law is territorial in nature, the TMA does not regard "shape" as a mark which is entitled to protection. The defendant cited Mahadev Shankar JCA's judgment in the Court of Appeal case of *Lim Yew Sing v. Hummel International Sports & Leisure A/S* [1996] 4 CLJ 784; [1996] 3 MLJ 7; and

(ix) the Registrar did not err in law in refusing to register the proposed trade mark.

**Relevant provisions in TMA, TMR and RC**

**[15]** The following provisions in the TMA are relevant to decide this OS:

Interpretation

s 3(1) **"mark" includes a device**, brand, heading, label, ticket, name, signature, word, letter, numeral **or any combination thereof**;

**"trade mark" means**, except in relation to Part XI, **a mark used or proposed to be used in relation to goods** or services **for the purpose of indicating or so as to indicate a connection in the course of trade between the goods** or services **and a person having the right either as proprietor or as registered user to use the mark** whether with or without an indication of the identity of that person, and means, in relation to Part XI, a mark registrable or registered under the said Part XI;

**Registrable trade marks**

10(1) **In order for a trade mark** (other than a certification trade mark) **to be registrable, it shall contain or consist of at least one of the following particulars**:

(a) the name of an individual, company or firm represented in a special or particular manner;

(b) the signature of the applicant for registration or of some predecessor in his business;

(c) an invented word or words;

(d) a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or

(e) **any other distinctive mark**.

(2) A name, signature or word which is not described in paragraph (1)(a), (b), (c) or (d) is not registrable unless it is by evidence shown to be distinctive.

(2A) *For the purposes of this section, "distinctive", in relation to the trade mark registered or proposed to be registered in respect of goods or services, means the trade mark must be capable of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection*

*subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.*

(2B) **In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which**:

(a) **the trade mark is inherently capable of distinguishing as aforesaid; and**

(b) **by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.**

(3) A trade mark may be registered in the Register in respect of any goods or services.

**Disclaimer**

s 18(1) If a trade mark:

(a) contains any part:

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains matter which is common to the trade or business or is not distinctive, the Registrar or the Court, in deciding whether the trade mark shall be entered or shall remain in the Register, may require as a condition of its being upon the Register, that the proprietor shall disclaim any right to the exclusive use of any such part or matter, to the exclusive use of which the Registrar or the Court holds him not to be entitled or that the proprietor shall make such other disclaimer as the Registrar or the Court may consider necessary for the purpose of defining his rights under the registration.

(2) No disclaimer on the Register shall affect any right of the proprietor of a trade mark except a right arising out of the registration of the trade mark in respect of which the disclaimer is made.

**Registration**

s 25(1) *Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may make application to the Registrar for the registration of that mark in the Register in the prescribed manner.*

(2) An application shall not be made in respect of goods or services comprised in more than one class.

(3) *Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such conditions, amendments, modifications or limitations, if any, as he may think right to impose.*

(4) In the case of refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the material used by him in arriving at the same.

(5) **A decision of the Registrar under subsection (3) is subject to appeal to the Court.**

(6) **An appeal under this section shall be made in the prescribed manner** and the Court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments, modifications or limitations, if any, the application is to be accepted.

(7) The appeal shall be heard on the material stated by the Registrar to have been used by him in arriving at his decision and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar other than those so stated except by leave of the Court.

(8) Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice in the prescribed manner.

(9) The Registrar or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application or may permit the applicant to amend his application upon such terms as he or it may think fit.

(10) Any application submitted and accepted under this section shall notwithstanding any correction or amendment permitted by the Registrar or the Court to be made in such application be deemed to have been made on the date of its original submission.

(11) (Repealed by Act A1078).

(12) Without prejudice to subsection (10) where after the acceptance of an application for registration of a trade mark but before the registration of the trade mark the Registrar is satisfied:

(a) that the application has been accepted in error; or

(b) that in the special circumstances of the case the trade mark shall not be registered or shall be registered subject to additional or different conditions or limitations,

the Registrar may withdraw the acceptance and proceed as if the application had not been accepted or, in respect only of a trade mark which shall be registered subject to additional or different conditions or limitations, reissue a new acceptance subject to additional or different conditions or limitations.

(emphasis added).

**[16]** Regulation 29 of the TMR provide as follows:

**Decision of Registrar**

29(1) The decision of the Registrar following a hearing as provided in subregulation 27(3) or 28(4) shall be communicated to the applicant in writing, and if the applicant objects to such decision he may, within two months from the date of its receipt, require, on Form TM 6, the Registrar to state in writing the grounds of, and the materials used by him in arriving at, his decision.

(2) In a case where the Registrar makes any requirements to which the applicant does not object, the applicant shall comply with the requirements before the Registrar issues the statement setting out the grounds of his decision.

(3) **The date when a statement is sent to the applicant under this regulation shall be deemed to be the date of the Registrar's decision for the purpose of appeal.**

(emphasis added).

**[17]** Order 3 r. 5, O. 32 r. 1 and O. 87 rr. 1, 3 and 8 of the RC state as follows:

Extension of time

Order 3 rule 5(1) The Court may, on such terms as it thinks just, by order extend or abridge the period within which a person is required or authorised by these Rules or by any judgment, order or direction, to do any act in any proceedings.

(2) The Court may extend any such period as referred to in paragraph (1) although the application for extension is not made until after the expiration of that period.

(3) *The period within which a person is required by these Rules, or by any order or direction, to serve, file or amend any pleading or other document may be extended by consent in writing without an order of the Court being made for that purpose.*

**Mode of making application**

Order 32 rule 1 **Every application in Chambers shall be made by notice of application in Form 57.**

**Interpretation**

Order 87 rule 1 In this Order:

"the Act" means the Trade Marks Act 1976;

**"Registrar" means the Registrar of Trade Marks appointed under section 4 of the Act.**

**Appeals by originating summons**

Order 87 rule 3 *An appeal to the Court under the Act shall be brought by originating summons within one calendar month from the date of decision appealed against.*

**Extension of time**

Order 87 rule 8 *The time specified in rules 3 and 5 of this Order may be extended by the Court or Registrar upon the application of any party interested and notwithstanding that the time so specified has expired.*

(emphasis added).

## Is This OS Time-barred?

**[18]** When I perused the cause papers of this OS, I noticed that this OS may be out of time by reason of O. 87 r. 3 of the RC (limitation issue). As the limitation issue was not raised by both parties, at the hearing of this OS, I informed learned counsel for both parties of the following:

(i) section 25(5) of the TMA provides the plaintiff with a right of appeal against the Registrar's refusal to the "court". According to s. 3(1) of the TMA, the word "court" means the High Court;

(ii) by reason of reg. 29(3) of the TMR, the date of the Registrar's refusal was 27 July 2015 when the Registrar's grounds were sent to the plaintiff's agent by way of the Registrar's letter dated 27 July 2015;

(iii) according to O. 87 r. 3 of the RC, the plaintiff's appeal against the Registrar's refusal by way of this OS "shall" be brought within one calendar month from 27 July 2015. As such, this OS should be filed on or before 27 August 2015; and

(iv) by way of the Registrar's letter dated 22 September 2015, the Registrar had given a two-month extension of time until 27 October 2015 for the plaintiff to file this OS (Registrar's extension). The Registrar's extension was given by the Registrar pursuant to O. 87 r. 8 of the RC. This OS was only filed on 3 November 2015 (seven days after the expiry of the Registrar's extension).

**[19]** The above facts regarding the limitation issue had been informed to learned counsel for both parties because the following cases had decided that parties have a right under the second rule of natural justice to be heard before this court decides on the limitation issue:

(i) the judgment of the Privy Council delivered by Lord Mustill in an appeal from Hong Kong, *Hoecheong Products Co Ltd v. Cargill Hong Kong Ltd* [1995] 1 WLR 404, at 408-409;

(ii) Lord Diplock's decision in the House of Lords case of *Hadmor Productions Ltd v. Hamilton* [1983] AC 191, at 233; and

(iii) Lord Diplock's judgment in *Hadmor Productions Ltd* had been cited by our Court of Appeal in a judgment delivered by Abdul Malik Ishak JCA in *Boustead Naval Shipyard Sdn Bhd v. Dynaforce Corporation Sdn Bhd* [2014] 5 CLJ 533; [2014] 4 AMR 317, at 329.

**[20]** In the finest tradition of the Bar, the plaintiff's learned counsel was candid and admitted that this OS had been filed out of time. I commended the plaintiff's learned counsel for her frankness.

**[21]** I am of the following view regarding the limitation issue:

(i) the one-month time period stipulated in O. 87 r. 3 of the RC is mandatory in view of the use of the imperative term "shall" in that provision – please see the Federal Court's judgment in *PP v. Yap Min Woie* [1995] 4 CLJ 692; [1996] 1 MLJ 169, at 172-173, regarding the mandatory effect of the word "shall" in a statutory provision;

(ii) section 25(6) of the TMA provides that an appeal under s. 25(5) of the TMA "shall be made in the prescribed manner", namely in the mandatory manner provided in O. 87 r. 3 of the RC;

(iii) the Registrar and/or the court has a discretion under O. 87 r. 8 of the RC to grant an extension of time to file this OS. If an extension of time is needed from the court:

(a) firstly there should be a notice of application filed by the plaintiff (plaintiff's application for extension) as required by O. 32 r. 1 of the RC – please see VC George J's (as he was then) decision in the High Court case of *Malayan United Finance Bhd, Johore Bahru v. Liew Yet Lan* [1989] 1 LNS 115; [1990] 1 MLJ 317, at 320; and

(b) secondly, the plaintiff's application for extension should be supported by an affidavit regarding the reasons why a second extension to file this OS was needed by the plaintiff when the Registrar's extension had previously been sought for and obtained by the plaintiff. In *Asia Commercial Finance (M) Bhd v. Pasadena Properties Development & Ors* [1990] 2 CLJ 961; [1990] 1 CLJ (Rep) 606; [1991] 1 MLJ 111, at 115 and 116, Zakaria Yatim J (as he was then) held as follows in the High Court:

> In my view it is left to the discretion of the court whether or not to extend the time under the above rule. The discretion to be exercised by the court is a judicial discretion. See *The Supreme Court Practice* 1985 Vol 1, p 15; and *Mallal's Supreme Court Practice* (2nd Ed) Vol 1, p 14. For the court to exercise its discretion whether or not to enlarge the time, there must be an affidavit to give reasons or to explain why the court should make an order to enlarge the time.
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> ...
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> *Although Tractors Malaysia v. Southern Estates* [1984] 1 MLJ 118, *Sri Jaya Transport v. Fernandez* [1970] 1 MLJ 87, and *Gan Hay Chong v. Siow Kian Yuh* [1975] 2 MLJ 129 were concerned with applications for extension of time to file notice of appeal to the Federal Court, in my view the principles laid down in those cases apply to the present case. There are two points to be noted in the Federal Court decisions. Firstly, the mistake of the appellant's solicitors or the solicitor's clerk is not sufficient ground to grant an extension of time. Secondly, in all those three cases affidavits were filed in support of the application for extension of time and the Federal Court took into consideration the affidavits filed in arriving at its decision. Even in the *Gatti* case [1939] 3 All ER 916 and *Palata* case [1984] 1 MLJ 118, the English Court of Appeal relied on the explanation contained in the applicants' affidavits before making its decision.
>
> In the present case, when I dismissed the appeal by the first and third defendant on 20 November 1989, there was a solicitor on record but he was absent. He had not filed any affidavit to explain or to give reasons why he was absent. As stated earlier the second defendant's averment for and on behalf of the first defendant in his affidavit is inadmissible. The explanation in the affidavit on the absence of the third defendant is not sufficient ground to grant the extension of time. In the absence of an affidavit giving sufficient grounds to justify an extension of time to enable the first and third defendants to apply for further argument, the second application was dismissed with costs.
>
> (emphasis added);

(iv) in this case, there was neither an application nor an affidavit from the plaintiff to apply for and justify a second extension of time to file this OS. On this ground alone, this OS should be dismissed with costs;

(v) I am aware that parties may consent in writing to an extension of time under O. 3 r. 5(3) of the RC but such a provision does not apply to this OS because O. 3 r. 5(3) of the RC only allows parties to consent in writing to an extension of time to serve, file or amend any pleading or other document beyond a time period as stipulated in the RC. Order 3 r. 5(3) of the RC cannot authorise an extension of time to file an action, especially when there is a specific time period to file this OS as provided in O. 87 r. 3 of the RC; and

(vi) if this OS is time-barred under O. 87 rr. 3 and 8 of the RC (despite the Registrar's extension), the court has no jurisdiction or competence to hear this OS and the parties' consent, election, waiver or acquiescence cannot confer jurisdiction or competence for the court to hear this OS.

**[22]** I will now proceed with this judgment on the assumption that the OS is not time-barred under O. 87 rr. 3 and 8 of the RC.

A **Can Court Refer To TRIPS Agreement?**

**[23]** Malaysia is a signatory to the TRIPS agreement on 1 January 1995. The following cases have decided that even if Malaysia is bound by a treaty in public international law, such a treaty is only enforceable in Malaysian municipal law if our Parliament has passed legislation to give effect to such a treaty:

B

(i) in the Federal Court case of *Bato Bagi & Ors v. Kerajaan Negeri Sarawak & Another Appeal* [2011] 8 CLJ 766; [2011] 6 MLJ 297, at para. 180, Raus Sharif FCJ (as he then was), decided as follows:

C

> [180] *On the issue whether this court should use 'international norms' embodied in the UNDRIP to interpret arts 5 and 13 of the Federal Constitution I have only this to say. International treaties do not form part of our law, unless those provisions have been incorporated into our law.*
>
> (emphasis added)

D

(ii) in *Airasia Bhd v. Rafizah Shima Mohamed Aris* [2015] 2 CLJ 510; [2014] 5 MLJ 318, at paras. 30, 35 and 37-41, Zawawi Salleh JCA held in the Court of Appeal as follows:

> [30] Before proceeding to discuss the issue, we would like to advert to some general discussions about CEDAW. *CEDAW was adopted by*
E
> *the General Assembly of the United Nations in 1979 and came into force in 1981. It is a landmark international agreement that affirms principles of human rights and equality for women around the world. As of April 2014, 188 states have ratified or acceded to treaty*. …
>
> [35] **Malaysia is a signatory to CEDAW and ratified it in 1995**. …
>
F
> [37] **In our considered opinion, CEDAW does not have the force of law in Malaysia because the same is not enacted into any local legislation.**
>
> [38] **In theoretical terms, the application of international legal systems is often explained in terms of the doctrines of incorporation**
G
> **(or monism) and transformation (or dualism).**
>
> [39] According to the doctrine of incorporation, international law is simply two components of single body of knowledge called law. Law is seen as a single entity of which international and municipal versions are merely particular manifestation. A judge can declare a municipal
H
> law invalid if it contradicts an international law because, in some states, the latter is said to prevail.
>
> [40] *The doctrine of transformation, on the other hand, holds that the two systems of law, international law and municipal law, are completely separate. A rule of international law can only become part of municipal law if and when*
I
> *it is transformed into municipal law by the passing of local legislation* (see Dinah Shelton (Ed), *International Law in Domestic Legal System: Incorporation, Transformation and Persuasion (Oxford University Press*, 2011); Brownlie, I, *Principles of International Law,* 3rd Ed, London, 1996, Chap 4).

> [41] *The practice in Malaysia with regard to the application of international law is generally the same as that in Britain, namely, the executive possesses the treaty-making capacity while the power to give effect domestically rests with parliament. For a treaty to be operative in Malaysia, therefore, it requires legislation by parliament*.
>
> (emphasis added); and

(iii) the judgment of Shankar J (as he then was) in the High Court case of *PP v. Narongne Sookpavit & Ors* [1985] 1 LNS 20; [1987] 2 MLJ 100, at 105:

> *As to this, Article 76(1) of the Malaysian Constitution provides the Federal Parliament with the competence to enact legislation for the purpose of implementing treaties, agreements or conventions between the Federation and any other country or any decision of any international organisation of which the Federation is a member. So before a Convention can come into force in Malaysia, Parliament must enact a law to that effect*. The Carriage by Air Act is one such example and the importation of the Geneva Convention on the Territorial Sea and the Contiguous Zone (1958) by the Emergency (Essential Powers) Ordinance No. 7 of 1969 is another. *No Malaysian statute has been cited to me to show that Article 14 had become part of Malaysian Law. In fact the Ordinance just cited stops at Article 13 and the irresistible inference must be that Article 14 was not intended to be imported into this country*.
>
> (emphasis added).

**[24]** Based on the above cases, I cannot refer to the TRIPS agreement unless it can be shown that the TRIPS agreement has been legislated by our Parliament as part of our municipal law. An example of the transformation of the Paris Convention for the Protection of Industrial Property of 20 March 1883 and revised at Stockholm on 14 July 1967 (Paris Convention) and TRIPS agreement into our Malaysian law is in s. 14(2) of the TMA (which provides that art. 6*bis* of the Paris Convention and art. 16 of the TRIPS agreement shall apply for the purpose of determining whether a trade mark is a well-known trade mark or otherwise).

**[25]** The definitions of "mark" and "trade mark" in s. 3(1) of the TMA do not refer to art. 15(1) or any other provision in the TRIPS agreement. Accordingly, no reference to the TRIPS agreement can be made in determining whether the definitions of "mark" and "trade mark" in s. 3(1) of the TMA include 3D marks.

**Does Definition Of "Mark" In s. 3(1) OF The TMA Include 3D Marks?**

**[26]** I am of the view that whether our definition of "mark" in s. 3(1) of the TMA includes a 3D mark, is a question of law on the construction of that definition (construction issue). I am not able to find any previous Malaysian case which has decided on the construction issue.

**[27]** Firstly, the construction issue cannot be answered by reference to the Registrar's manual. This is because the Registrar's manual does not constitute "law". Section 3 of the Interpretation Acts 1948 and 1967 (IA) provides that the term "law" has the meaning assigned by art. 160(2) of the Federal Constitution (FC). Article 160(2) of the FC provides:

> **"law" includes written law, the common law in so far as it is in operation in the Federation or any part thereof, and any custom or usage having the force of law in the Federation or any part thereof;**
>
> (emphasis added).

The term "written law" is defined in s. 3 of the IA to mean, among others, FC, State Constitutions, Acts of Parliament and subsidiary legislation made thereunder.

It is clear that the Registrar's manual is not "law" and "written law" within the meaning of s. 3 of the IA read with art. 160(2) of the FC. In any event, para. 1.3 of the Registrar's manual states that the Registrar's manual "is intended primarily for the guidance and instruction of the staff of the Trade Marks Registry".

**[28]** Secondly, the construction issue cannot be answered by referring to previous 3D trade marks which have been registered by the Registrar, including the plaintiff's two registered trade marks. The Registrar's practice, past and present, in my opinion, cannot be resorted to in ascertaining the scope of the definition of "mark" in s. 3(1) of the TMA. Furthermore, the validity of registered 3D trade marks has yet to be decided by the court and such registered 3D trade marks may be subsequently invalidated by the court.

**[29]** Thirdly, I cannot accept the plaintiff's contention that the proposed trade mark was an extension of the plaintiff's two registered trade marks. This is because irrespective of the plaintiff's two registered trade marks, the Registrar is obliged in law under s. 25(3) of the TMA to exercise his or her discretionary power to decide every application to register a trade mark in accordance with the TMA and TMR. In the House of Lords case of *Registrar of Trade Marks v. W & G Du Cros Ltd*, at p. 629, Lord Shaw described the Registrar's discretionary power to decide an application to register a trade mark under the TMA 1938 (UK) as follows:

> *... I allude to the view taken by the Court of Appeal with regard to the position and duty of the Registrar of Trade Marks. My Lords, in my opinion, that official, when an application for registration is made, has not only an administrative but also a quasi-judicial function. I think that he has to exercise a discretion, exercising it, of course, in a judicial spirit. To use the words of Lord Herschell in Eno's Case (1), "while he is in certain cases prohibited from registering, a discretion whether to register or not seems in all cases plainly conferred. Of course this discretion must be reasonably and not capriciously exercised.*

> *But in the next place, I think that those provisions of the statute, to which I am about to refer, shew that his action is not merely of a preliminary character (passing on the case to the stage when opponents of the registration may appear), but is of the character of a judicial pronouncement on the merits of the application itself.* (emphasis added).

If a trade mark registration application is allowed merely on the ground that the trade mark is an extension of a previous registered trade mark, the Registrar would have unlawfully abdicated his or her *quasi*-judicial discretionary power to decide that application to register a trade mark under s. 25(3) TMA.

**[30]** Fourthly, I cannot accede to the plaintiff's contention that since there was no disclaimer in respect of the plaintiff's two registered trade marks, the plaintiff was entitled to the registration of the proposed trade mark by the Registrar. According to s. 18 TMA, a proprietor of a registered trade mark is not entitled to the exclusive use of the registered trade mark in respect of a disclaimed use. If there is no disclaimer under s. 18 TMA, a proprietor of a registered trade mark has the exclusive right under s. 35(1) TMA to use the registered trade mark. The lack of a disclaimer in respect of one previously registered trade mark, does not *ipso facto* mean that another subsequent trade mark should be registered by the Registrar under s. 25(3) TMA.

**[31]** Fifthly, the construction issue cannot be decided by referring to the definition of an "industrial design" in s. 3(1) IDA. Nor can the construction issue be resolved by referring to the present trade marks legislation in UK, Singapore and Australia which are materially different from our definitions of "mark" and "trade mark" in s. 3(1) TMA. I refer to the present trade marks legislation in UK, Singapore and Australia as follows:

(i) section 1(1) TMA 1994 (UK) provides that a trade mark may consist of, among others, "the shape of goods or their packaging";

(ii) section 2(1) of Singapore's Trade Marks Act (Chapter 332) (**TMA (Singapore)**) defines a "trade mark" as "any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person". According to s. 2(1) TMA (Singapore), a "sign" includes any "any letter, word, name, signature, numeral, device, brand, heading, label, ticket, **shape, colour, aspect of packaging or any combination thereof**. (emphasis added); and

(iii) section 17 of Australia's Trade Marks Act 1995 (**TMA 1995 (Australia)**) provides that a "trade mark" is a "sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person". Section 6 TMA 1995 (Australia) defines

A a "sign" to include the "**following or any combination of the following**, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, **aspect of packaging, shape, colour, sound or scent**" (emphasis added).

B **[32]** My research has revealed the following opinion by Mr Teo Bong Kwang in his book, "*Trade Mark Law and Practice*" (2001), at p. 88:

> The shape of the product is generally not acceptable as a trade mark.

The footnote of the above opinion referred to *Coca Cola*'s case.

C **[33]** I am of the view that a 3D mark falls within the meaning of a "mark" in s. 3(1) TMA for the following reasons:

(i) our TMA is based on TMA 1938 (UK) and in particular, the definitions of "mark" and "trade mark" in s. 3(1) TMA are in *pari materia* with the definitions of "mark" and "trade mark" in s. 68(1) TMA 1938 (UK). Hence, the persuasiveness of English cases on TMA 1938 (UK). I refer to Lord Diplock's judgment in the House of Lords case of *Smith Kline and French Laboratories Ltd* as follows:

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(a) The appellant pharmaceutical company applied to register 3D marks consisting of small spherical pellets enclosed in capsules with certain colour combinations (3D pharmaceutical marks);

E

(b) The respondent pharmaceutical company opposed the registration of the 3D pharmaceutical marks;

(c) The UK's Assistant Registrar of Trade Marks (UK Registrar) decided that the 3D Pharmaceutical Marks were "trade marks" under s. 68(1) TMA 1938 (UK) but refused registration on the ground that the 3D pharmaceutical marks were not inherently distinctive;

F

(d) Graham J in the High Court allowed the appellant's appeal but ordered that each registration of the 3D pharmaceutical marks be limited to the particular drug for which the particular colour combination had been used by the appellant, rather than the class of drugs as a whole;

G

(e) The Court of Appeal held that the 3D pharmaceutical marks were not "marks" under s. 68(1) TMA 1938 (UK); and

H

(f) The House of Lords unanimously reversed the Court of Appeal's decision and ordered the registration of the 3D pharmaceutical marks.

I

Lord Diplock, at p. 582, decided as follows in *Smith Kline and French Laboratories Ltd*:

> *'Trade mark' is so defined as to limit its meaning to a mark which serves a particular purpose. 'Mark', on the other hand, is not defined in such a way as to prevent there being ascribed to it its ordinary meaning in the English language as well as those more specific meanings stated to be included in the expression 'mark'. As reference to any dictionary will show, 'mark' is a word which in ordinary speech is capable of bearing a wide range of meanings according to the context in which it is used*. For present purposes the relevant context in which it is used is that of the definition of 'trade mark'.
>
> ...
>
> *So, if it is to be a trade mark, a 'mark' must be something that can be represented visually and may be something that can be applied to the surface of the goods ('use upon') or incorporated in the structure of the goods ('use in physical relation to'). The inclusion of 'heading' (viz coloured threads woven into the selvedge of textile goods) in the meaning of 'mark' also confirms that a mark, provided that it can be seen on visual examination of the goods, may be incorporated in their structure.*
>
> **My Lords, I see nothing in this context that requires one to exclude from the definition of 'trade mark' a mark which covers the whole of the visible surface of the goods to which it is applied**. Such a mark is as capable of indicating a connection in the course of trade between the goods and the proprietor of the mark as it would have been if it had only covered half or three-quarters of the visible surface. No one has been able to point to any business purpose that would be served by drawing a distinction between marks that cover the whole and those which cover part of the surface. For my part I should be loth to ascribe to Parliament an intention to do anything so irrational.
>
> (emphasis added).

I accept the above judgment of Lord Diplock in *Smith Kline & French Laboratories Ltd* as applicable in the interpretation of the term "mark" in s. 3(1) of the TMA;

(ii) a 3D mark may be a "device" as stated in the definition of a "mark" in s. 3(1) of the TMA. This is because a 3D mark falls within the dictionary meaning of the word "device" as follows:

(a) The online *"Oxford Dictionaries"* explains a "device" as, among others, a "thing made or adapted for a particular purpose";

(b) The online *"Cambridge English Dictionary"* defines a "device" as, among others, "an object or machine that has been invented to fulfil a particular purpose"; and

(c) The online *"Merriam-Webster Dictionary"* states that a "device" is, among others, "an object, machine, or piece of equipment that has been made for some special purpose"; and

(iii) the definition of "mark" in s. 3(1) of the TMA is a wide one by reason of Parliament's use of the word "includes". I rely on the judgment of Raja Azlan Shah CJ (Malaya) (as His Majesty then was) in the Federal Court case of *Hj Abdul Ghani Ishak & Anor v. PP* [1981] 1 LNS 96; [1981] 2 MLJ 230, at 245-246, as follows:

> *The first question to answer on the definition is whether it is intended to be exhaustive. After carefully examining the definition we are of the opinion that the question should be answered in the negative, that is the definition of "corrupt practice" in the Ordinance is not exhaustive but extensive*. In properly considering the definition the words "without prejudice to the foregoing" appearing before the second limb of the definition are important. These words indicate the general intendment of the first limb of the definition. *In fact the extensive character of the definition is further enhanced by the use of the word "includes" immediately after the words "in relation to a Member of a State Legislative Assembly" appearing in the second limb of the definition. The word "includes" is normally used to enlarge the ordinary meaning of a word or phrase beyond its accepted meaning as opposed to the use of the word "means" which is used if the definition is intended to be exhaustive – see Caldow Props v. Low Ltd* [1971] NZLR 311, 320. ...
>
> (emphasis added).

**[34]** I have not overlooked *Coca Cola*'s case which has been cited by learned counsel for the Registrar. In *Coca Cola*'s case:

(i) the Coca Cola Company applied to register the shape of its distinctive bottle (bottled shape mark) as a trade mark;

(ii) the UK Registrar, High Court and Court of Appeal unanimously rejected the registration of the bottled shape mark as a trade mark; and

(iii) the Coca Cola Company's appeal to the House of Lords was dismissed.

Lord Templeman decided as follows at p. 276:

> *It is not sufficient for the Coca-Cola bottle to be distinctive. The Coca-Cola Co must succeed in the startling proposition that the bottle is a trade mark. If so, then any other container or any article of a distinctive shape is capable of being a trade mark. This raises the spectre of a total and perpetual monopoly in containers and articles achieved by means of the 1938 Act. Once the container or article has become associated with the manufacturer and distinctiveness has been established, with or without the help of the monopolies created by the Patents Act, the Registered Designs Act or the Copyright Act, the perpetual trade mark monopoly in the container or article can be achieved. In my opinion the 1938 Act was not intended to confer on the manufacturer of a container or on the manufacturer of an article a statutory monopoly on the ground that the manufacturer has in the eyes of the public established a connection between the shape of the container or article and the manufacturer. A rival manufacturer must be free to sell any container or article of similar shape provided the container or article is labelled or packaged in a manner which avoids confusion as to the origin of the goods in the container or the origin of the article. The Registrar of Trade Marks has always taken the view that the function of trade mark legislation is to protect the mark but not the article which is marked. I agree.* By s 68(1) of the Act of 1938:

...

*The word 'mark' both in its normal meaning and in its statutory definition is apt only to describe something which distinguishes goods rather that the goods themselves. A bottle is a container not a mark. The distinction between a mark and the thing which is marked is supported by authority. In Re James's Trade Mark, James v. Soulby (1886) 33 Ch D 392, the plaintiffs sold black lead in the form of a dome and in other shapes. Their products were impressed with the representation of a dome and their labels carried a picture of a black dome. The plaintiffs were allowed to register the representation or picture of a black dome as their trade mark. Similarly, the Coca-Cola Co has been allowed to register a line drawing of a Coca-Cola bottle as a trade mark. But, dealing with the article itself, in Re James's Trade Mark Lindley LJ said* (at 395):

> *A mark must be something distinct from the thing being marked. The thing itself cannot be a mark of itself, but here we have got the thing and we have got a mark on the thing, and the question is, whether that mark on the thing is or is not a distinctive mark within the meaning of the Act. Of course the plaintiffs' in this case have no monopoly in black lead of this shape. Anybody may make black lead of this shape provided he does not mark it as the plaintiffs mark theirs, and provided he does not pass it off as the plaintiffs' black lead. There is no monopoly in the shape, and I cannot help thinking that that has not been sufficiently kept in mind. What the plaintiffs have registered is a brand, a mark like a dome intended to represent a dome.*

In the course of argument counsel for the Coca-Cola Co relied on the decision of this House in *Smith Kline and French Laboratories Ltd v. Sterling-Winthrop Group Ltd* [1975] 2 All ER 578, [1975] 1 WLR 914. In that case the plaintiffs were allowed to register 10 distinctive colour combinations as trade marks for drugs sold in pellet form within capsules. One typical example was ([1975] 2 All ER 578, at 581 [1975] 1 WLR 914 at 916):

> The trade mark consists of a maroon colour applied to one half of the capsule at one end, and the other half being colourless and transparent, and yellow, blue and white colours being each applied to a substantial number of pellets so that each pellet is of one colour only.

Lord Diplock rejected the argument that a mark could not cover the whole of the visible surface of the goods to which it was applied (see [1975] 2 All ER 578, at 584, [1975] 1 WLR 914 at 920). *The Smith Kline case only related to the colour of goods and has no application to the goods themselves or to a container for goods. A colour combination may tend to an undesirable monopoly in colours but does not create an undesirable monopoly in goods or containers. I do not consider that the Smith Kline case is of assistance to the Coca-Cola Co. I would accordingly dismiss this appeal.*

(emphasis added).

**[35]** With the greatest respect, I am inclined to follow *Smith Kline & French Laboratories Ltd* and not *Coca Cola*'s case. My reasons are as follows:

(i) a 3D mark falls within the meaning of "mark" in s. 3(1) of the TMA as explained in *Smith Kline & French Laboratories Ltd* and the above para. 33. There is nothing in the definition of "mark" in s. 3(1) of the TMA which excludes 3D marks in the form of containers; and

(ii) in the Federal Court case of *Yong Teng Hing B/S Hong Kong Trading Co & Anor v. Walton International Ltd* [2012] 6 CLJ 337, at para. 7, Zulkefli Makinudin CJ (Malaya) held as follows:

> *… We agree with the submission of learned counsel for the respondent that the entitlement to a trade mark is dependent on a number of factors. Such factors for consideration are whether the applicant is the bona fide proprietor of the trade mark pursuant to s. 25 of the Act and whether the trade mark qualifies for registration pursuant to s. 10 of the Act particularly whether the mark is distinctive of the applicant. A factor to be also considered is whether the trade mark shall be prohibited from registration pursuant to other provisions of the Act, such as ss. 14 and 19 of the Act*.
>
> (emphasis added).

Based on *Yong Teng Hing*, a 3D "shape mark" in the form of a container may be registered as a trade mark upon the fulfilment of all the following conditions:

(a) The applicant is the *bona fide* proprietor of the 3D "shape mark" under s. 25(1) of the TMA;

(b) The 3D "shape mark" is distinctive of the applicant's goods under s. 10(1)(e), (2A) and (2B) of the TMA (which will be discussed later in this judgment); and

(c) The registration of the 3D "shape mark" is not prohibited by TMA, such as ss. 14 or 19 of the TMA.

It is clear that our TMA does not prohibit the registration of a 3D "shape mark" in the form of a container mark merely because the 3D mark is in the form of a container.

**Is Proposed Trade Mark A "Trade Mark" Under s. 3(1) Of The TMA?**

**[36]** As I have decided that a 3D mark is a "mark" under s. 3(1) of the TMA, the next question that arises is whether the proposed trade mark is a "trade mark" under s. 3(1) of the TMA.

**[37]** I am of the view that the proposed trade mark is not a "trade mark" as understood in s. 3(1) of the TMA because there is nothing in the proposed trade mark which would indicate a connection in the course of trade between the plaintiff's goods and the plaintiff. Accordingly, on this ground alone This OS should be dismissed with costs.

**Was Proposed Trade Mark Distinctive Of The Plaintiff's Goods?**

**[38]** I agree with the contention of the plaintiff's learned counsel that s. 10(1)(a) to (d) of the TMA do not apply to the proposed trade mark.

**[39]** It is not disputed that the plaintiff bears the legal burden to prove that the proposed trade mark is distinctive under s. 10(1)(e) and (2A) of the TMA in the sense that the proposed trade mark must be capable of distinguishing the plaintiff's goods in the course of trade from the goods of other traders.

**[40]** The relevant date for the plaintiff to prove the proposed trade mark's distinctiveness is 7 June 2012, the date of the plaintiff's application to register the proposed trade mark – please see the Federal Court's judgment in *Yong Teng Hing*, at para. 7.

*Application Of s. 10(2B)(a) And (b) TMA*

**[41]** Section 10(2B)(a) and (b) TMA provides two tests of distinctiveness as follows:

(i) whether the proposed trade mark is inherently capable of distinguishing the plaintiff's goods in the course of trade from the goods of other traders (inherent distinctiveness) – s. 10(2B)(a) of the TMA; and

(ii) whether by reason of:

(a) The use of the proposed trade mark; and/or

(b) Any other circumstances

- the proposed trade mark is in fact capable of distinguishing the applicant's goods in the course of trade from the goods of other traders (Factual Distinctiveness) – s. 10(2B)(b) of the TMA.

**[42]** Our s. 10(2B)(a) and (b) of the TMA are similar to s. 9(3)(a) and (b) of the TMA 1938 (UK). Section 10(2B) of the TMA uses the term "may" but the following English cases on s. 9(3) of the TMA 1938 (UK) have construed the word "may" as a "must":

(i) in *Yorkshire Copper Works Ltd v. Registrar of Trade Marks* [1954] 1 All ER 570, at 571-572, Lord Simonds LC decided as follows in the House of Lords:

> ... These I have set out and I only make this comment, that, though I can think of no other factor relevant to distinctiveness than those set out in sub-s (3), yet if there is such a factor, it would be the right and duty of the registrar to take it into consideration. I do not think it necessary to discuss whether the word "may" means "must", for I cannot conceive that, as a practical matter, the registrar could ignore either of the factors (a) or (b).
>
> The position, then, is this, that the registrar will have to consider both the inherent adaptability and the distinctiveness in fact of a geographical name before he makes his decision. ...

(emphasis added); and

(ii) in *Blue Paraffin Trade Mark*, at 483, Whitford J in the High Court followed *Yorkshire Copper Works Ltd* and held as follows:

> *As a result of a number of cases in the appellate courts, it is now clearly established by decisions binding on this court that under s 9(3) [TMA 1938 (UK)], although the statute says the Registrar may have regard to two factors, he cannot disregard one of them. He must take them both into account. That is to say, in subsection (3), "may" means the same as "must" in subsection (1).*
>
> (emphasis added).

Whitford J's decision in *Blue Paraffin Trade Mark* had been affirmed by the Court of Appeal.

**[43]** I am of the opinion that *Yorkshire Copper Works Ltd* and *Blue Paraffin Trade Mark* apply in respect of s. 10(2B) of the TMA. Accordingly, the word "may" in s. 10(2B) of the TMA is construed to be mandatory and the Registrar must consider both the inherent and factual distinctiveness of the proposed trade mark in this case.

*Was Proposed Trade Mark Inherently Distinctive?*

**[44]** In *Registrar of Trade Marks v. W & G Du Cros Ltd*, at 634-635, Lord Parker in the House of Lords held as follows regarding the then UK's Trade Marks Act 1905:

> My Lords, *if either mark be registrable, it must be because it is a distinctive mark within the meaning of s. 9, sub-s. 5, of the Act. "Distinctive" is defined as meaning "adapted to distinguish the goods of the applicant for registration from the goods of other persons." This definition is found for the first time in the Act of 1905, but the word "distinctive" was, I think, used in all the earlier Acts in the sense of "adapted to distinguish." ... In my opinion, in order to determine whether a mark is distinctive it must be considered quite apart from the effects of registration. The question, therefore, is whether the mark itself, if used as a trade mark, is likely to become actually distinctive of the goods of the person so using it. The applicant for registration in effect says, "I intend to use this mark as a trade mark, i.e., for the purpose of distinguishing my goods from the goods of other persons," and the Registrar or the Court has to determine before the mark be admitted to registration whether it is of such a kind that the applicant, quite apart from the effects of registration, is likely or unlikely to attain the object he has in view. The applicant's chance of success in this respect must, I think, largely depend upon whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods. It is apparent from the history of trade marks in this country that both the Legislature and the Courts have always shewn a natural disinclination to allow any person to obtain by registration under the Trade Marks Acts a monopoly in what others may legitimately desire to use. ... but before such a mark be accepted the Registrar or the Court has to be satisfied that it is adapted to distinguish the goods of the applicants from those of others. It need not necessarily be so adapted, and*

*whether it is or is not so adapted appears to depend largely on whether other traders are or are not likely to desire in the ordinary course of their business to make use in connection with their goods of the particular letter or letters constituting the mark.*

(emphasis added).

**[45]** The above ruling by Lord Parker in *Registrar of Trade Marks v. W & G Du Cros Ltd* has been affirmed in *Smith Kline and French Laboratories Ltd*, at pp. 585-586 (regarding the then s. 9 of the TMA 1938 (UK)), as follows:

... The reference to inherent adaptability would at first sight appear more apt where the mark has not already been used by the applicant in the course of his trade before the date of the application. However, *long before the reference to inherent adaptability had been incorporated in the current statutes dealing with trade marks, it had been held on grounds of public policy that a trader ought not to be allowed to obtain by registration under the Trade Marks Act a monopoly in what other traders may legitimately desire to use. The classic statement of this doctrine is to be found in the speech of Lord Parker in Trade Marks Registrar v. W & G du Cros Ltd* ([1913] AC 624 at 635) *where he said that the right to registration should:*

> *largely depend on whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.*

*The reference to 'inherently adapted' in s 9(3) of the consolidation Act of 1938, which was first enacted in 1937, has always been treated as giving statutory expression to the doctrine as previously stated by Lord Parker.*

(emphasis added).

**[46]** *Registrar of Trade Marks v. W & G Du Cros Ltd* and *Smith Kline & French Laboratories Ltd* have been applied by Ramly Ali J (as he then was) in the High Court case of *Illinois Tool Works, Inc v. Pendaftar Cap Dagangan, Malaysia* [2010] 3 CLJ 837, in paras. 73 and 74.

**[47]** Applying the inherent distinctiveness test laid down in *Registrar of Trade Marks v. W & G Du Cros Ltd*, on 7 June 2012, there might be traders who were likely, in the ordinary course of their business and without any improper motive, to desire to use the proposed trade mark or some other mark nearly resembling the proposed trade mark, upon or in connection with their own goods. Furthermore, on 7 June 2012, the proposed trade mark did not possess any feature which was capable of distinguishing the plaintiff's goods in the course of trade from the goods of other traders. Accordingly, on 7 June 2012, the proposed trade mark was not inherently distinctive of the plaintiff's goods within the meaning of s. 10(2B)(a) of the TMA.

*Did Plaintiff Prove Factual Distinctiveness Of Proposed Trade Mark?*

**[48]** The plaintiff had not adduced proof of use of the proposed trade mark or any other circumstances on 7 June 2012 to show that the proposed trade mark was in fact capable of distinguishing the plaintiff's goods in the course

of trade from the goods of other traders. This is because the plaintiff has only used the proposed trade mark with the "TOBLERONE" name on or in relation to the plaintiff's goods. There is no evidence that on 7 June 2012, the plaintiff had used the proposed trade mark without the "TOBLERONE" name. There is therefore no evidence of the factual distinctiveness of the proposed trade mark on 7 June 2012 as understood in s. 10(2B)(b) of the TMA.

**[49]** In view of the above evidence and reasons, I find as fact that the plaintiff has failed to discharge the legal onus to prove that on 7 June 2012 the proposed trade mark was inherently and/or factually distinctive of the plaintiff's goods under s. 10(1)(e), (2A), (2B)(a) and (b) of the TMA. On this ground alone, this OS should be dismissed with costs.

*Relationship Between ss. 10 And 25 Of The TMA*

**[50]** Section 25(3) of the TMA has expressly provided that the power of the Registrar to decide an application to register a trade mark, is subject to the provisions of the TMA. It is clear that s. 25(3) of the TMA is subject to, among others, s. 10(1)(e), (2A), (2B)(a) and (b) of the TMA. Upon the plaintiff's failure to prove the inherent and/or factual distinctiveness of the proposed trade mark on 7 June 2012 (as required by s. 10(1)(e), (2A), (2B)(a) and (b) of the TMA), the Registrar is duty bound to refuse the plaintiff's application in this case.

**Court's Decision**

**[51]** In view of the above evidence and reasons, this OS is dismissed with costs.